

REMARKS

I. Introduction

Claims 1-14 are currently pending in the present application. Claims 2, 6-9, 13 and 14 have been withdrawn from further consideration. Claims 1, 3-5 and 10-12 are under consideration and stand rejected. Claims 1-14 have been amended.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that certified copies of the priority documents have been received in this National Stage application from the International Bureau.

II. Drawings

The Examiner objected to Fig. 3 because “D” is allegedly incorrectly shown, i.e., it should be “a co-focal length of the objective lens as claimed.” Applicant notes that the term “co-focal length” appearing in the English translation of the base PCT application is a mistranslation; instead, the term should be “parfocal distance.” In this regard, the specification and the claims have been corrected accordingly. The “parfocal distance” is defined as a distance from the sample to the objective lens shoulder. Therefore, the distance indicated by the reference symbol “D” in FIG. 3 is not changed. In addition, Fig. 3 has been amended to show D1, D3, FTL and Fe.

In Figs. 8 and 9, the reference symbols r24 and r25 have been exchanged, in order to render the drawings to be consistent with the numerical data in the specification. In Fig. 10, the reference symbols r25 and r26 have been exchanged, in order to render the drawings to be consistent with the numerical data in the specification. Since Figs. 8-10 are complex drawings with numerous line, and inclusion of additional lines and legends would render the drawings less intelligible, Applicant believes it is more helpful to fully define the distance represented by references symbols D, D1, D2, and D3 in the specification, with reference to each lens data of the embodiments of Figs. 8-10. Regarding Fe, FTL and FTL1, these are conceptual terms of the geometric optics and thus are not suitable for graphical representation in Figs. 8-10. However, since Fig. 3 is a schematic diagram in which the lenses are ideally shown as singlet lenses with thickness of zero, Applicant has added Fe and FTL which can be of help in understanding the invention.

III. Specification

In response to the Examiner's objection to the abstract of the disclosure, Applicant has amended the Abstract to eliminate legal phrases. Withdrawal of the objection is respectfully requested.

In response to the Examiner's request for Applicant's cooperation in correcting any errors in the specification, Applicant has corrected errors in the Specification.

IV. Rejection of Claims 1, 3-5 and 10-12 under 35 U.S.C. § 112, second paragraph

Claims 1, 3-5 and 10-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, Applicant has amended the claims in accordance with the Examiner's suggestion to eliminate any informality and further clarify the claimed subject matter. Accordingly, withdrawal of the indefiniteness rejection is requested.

V. Rejection of Claims 1 and 12 under 35 U.S.C. § 103(a)

Claims 1 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US 2004/0159797 A1 ("Wolleschensky"). Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements" in the manner claimed. See KSR Int'l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be

sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Amended claim 1 recites, in relevant parts, “wherein the following condition is satisfied: $0.15 \leq D/L \leq 0.5$ where D is a parfocal distance of the objective lens, and L is a distance from the surface of the sample to the position conjugate with the back focal position of the objective lens and located near the scanning device.” According to the present specification, parfocal distance D is defined as a “distance from the sample surface to the objective lens shoulder on the body.” To the extent the Examiner relies on Fig. 8 of Wolleschensky in support of the rejection, Applicant notes that Fig. 8 fails to show an objective lens shoulder, and therefore it is impossible to define the parfocal distance D from Fig. 8 of Wolleschensky.

Independent of the above, even if one assumes for the sake of argument that a distance from O to PR (or P3 to PR) in Fig. 8 of Wolleschensky may somehow be argued as being equivalent to the claimed parfocal distance D, Fig. 8 of Wolleschensky is a schematic diagram illustrating the microscope for explaining the function of individual lenses from the scanning means (SX, SY) to the sample (PR) of the confocal microscope, which schematic diagram is not drawn to scale (particularly with respect to relative proportions between different components), and thus the length in the drawing clearly cannot be translated into any actual dimension. As admitted by the examiner, there is no teaching in Wolleschensky that the conjugate positions are at equal distances. Indeed, the distance from SY to PR would be 400mm to 600mm (in order to approximate the disclosure of the present specification), while the distance from O to PR would be 45mm to 60mm (in order to approximate the disclosure of the present specification), and it is simply untenable to suggest that such information is conveyed regarding the actual proportions of the apparatus in the schematic illustration of Wolleschensky. Therefore, at best, Wolleschensky merely illustrates a

schematic diagram which is not drawn to scale, particularly with respect to relative proportions between different components.

Independent of the above, to the extent the Examiner contends that Wolleschensky teaches using equal focal lengths for optics in the 4f system of Fig. 5, Applicant notes that the system of Wolleschensky is a configuration used for efficiently separating illumination light from detection light, and is not the configuration of the present invention or a basic configuration of a common confocal microscope. With reference to Fig. 2 and Fig. 8 of Wolleschensky, the configuration from the scanner via the tube lens to the objective preparation in Fig. 2, and the configuration from SX (SY is equivalent to SX) to PR of Fig. 8, are same as the configuration from the scanning means to the sample of a common confocal microscope (which is suggested in paragraph [0063]). That is, this configuration of Wolleschensky does not solve the problem of overly long distance from the sample to the scanning means, solution to which problem is the object of the present invention.

For at least the foregoing reasons, claim 1 and its dependent claim 12 are not rendered obvious by Wolleschensky.

VI. Rejection of Claim 11 under 35 U.S.C. § 103(a)

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over US 2004/0159797 A1 ("Wolleschensky") in view of U.S. Patent No. 6,690,511 ("Engelhardt et al."). Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

Amended claim 11 depends on claims 3, 4 and 5, all of which have been rewritten in independent form and are now in allowable condition as per the Examiner's comments (see section VIII below). According, dependent claim 11 is also in allowable condition.

VII. Rejection of Claim 10 under 35 U.S.C. § 103(a)

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over US 2004/0159797 A1 ("Wolleschensky") in view of U.S. Patent No. 6,282,020 ("Ogino"). Applicant respectfully submits that the rejection should be withdrawn for at least the

following reasons.

Amended claim 10 depends on claims 3, 4 and 5, all of which have been rewritten in independent form and are now in allowable condition as per the Examiner's comments (see section VIII below). According, dependent claim 10 is also in allowable condition.

VIII. Allowable Subject Matter

The Examiner indicated that claims 3-5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, set forth in this Office Action, and to include all of the limitations of the base claim and any intervening claims. Since claims 3, 4 and 5 have been amended to be in independent form in accordance with the Examiner's suggestion, claims 3, 4 and 5 are now in allowable condition.

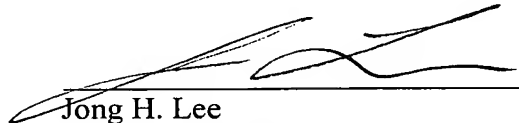
IX. CONCLUSION

In view of all of the above, it is respectfully submitted that all of the presently pending claims 1, 3-5 and 10-12 under consideration are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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